REMARKS

I. Introduction

As a result of this response, claims 11-12 and 16-18 of the present application are currently being considered, have been rejected by the Office Action, and continue unamended. Claims 1-10 and 13-15 have been previously canceled.

In view of the following remarks, it is respectfully submitted that claims 11-12 and 16-18 are allowable, and reconsideration of these claims is respectfully requested.

II. Rejection of Claims 11-12 and 16-18 Under 35 U.S.C. § 103(a)

Claims 11-12 and 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent No. JP2001198141A to Kudo et al. (hereinafter "the Kudo reference") in view of U.S. Patent No. 6,081,371 to Shioda et al. (hereinafter "the Shioda '371 reference") and U.S. Patent Application Publication No. 2001/0055062A1 to Shioda et al. (hereinafter "the Shioda '062 reference"). The Applicant respectfully submits that this rejection should be withdrawn for at least the following reasons.

In rejecting a claim for obviousness under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fe d. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent claim 11, as presented, recites a "*microscopic observing apparatus comprising: a probe microscope; an auxiliary microscope; a specimen stage on which is placed a subject of observation that is to be observed using the probe microscope and the auxiliary microscope, and that allows an absolute position of the subject of observation to be adjusted; a laser light irradiation device that irradiates laser light that is coaxial with the optical axis of the probe microscope onto the subject of observation; and a microscope holding member that holds both of the probe microscope and the auxiliary microscope on the*

specimen stage, wherein the auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible."

The Kudo reference does not identically disclose, or even suggest, at least the above-identified claim features. The Applicants respectfully note that the Office Action states that "*Kudo et al. disclose ... except for the light source being a laser that is coaxial with the optical axis of the probe microscope.*" The Applicants agree that the Kudo reference does not disclose the claimed "*laser light irradiation device that irradiates laser light that is coaxial with the optical axis of the probe microscope.*"

Moreover, the Applicants respectfully submit that the Kudo reference also does not identically disclose, or even suggest, the claimed "*laser light irradiation device that irradiates laser light that is coaxial with the optical axis of the probe microscope onto the subject of observation.*" The Office Action states "*Kudo et al. disclose ... a light irradiation device (not shown, see paragraph [0015] of machine translation) that irradiates light onto the subject (32) of observation.*" However, the Applicants respectfully disagree that the Kudo reference provides such a teaching. The portion of the Kudo reference cited by the Office Action, i.e., paragraph [0015], in fact only states "*[f]urthermore, the support device 62 which supports the mirror body 2 of an operation microscope 1 movable in the direction of arbitration is formed in the upper part of a stanchion 5. The 1st arm 6, the 2nd arm 7, and the 3rd arm 8 are formed in this support device 62. Here, the light source for lighting which is not illustrated is built in the 1st arm 6. And the end section of this 1st arm 6 is attached in the upper part of a stanchion 5 free [rotation] centering on the shaft O1 of the direction of an abbreviation vertical.*" Thus, the Kudo reference only states that a light source for lighting is built into the 1st arm 6. However, the Kudo reference stating that a light source for lighting is built into 1st arm 6 says nothing about what the light source lights. For example, the light source may not be for lighting the subject of observation, but may instead be for lighting the general area of the operating microscope apparatus, e.g. the room in which the operating microscope apparatus of the Kudo reference has been placed. Indeed, 1st arm 6, as shown in Figure 1 of the Kudo reference, is very far away from the subject of observation. The Kudo reference simply does not provide any teaching that the light source lights the subject of observation. Thus, the Kudo reference also does not disclose, or even suggest, the claimed "*laser light irradiation device that irradiates laser light that is coaxial with the optical axis of the probe microscope onto the subject of observation.*"

Furthermore, the Applicants respectfully submit that the Kudo reference also does not identically disclose, or even suggest, the claimed "*auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible*." The Office Action states "*Kudo et al. disclose ... a light irradiation device (not shown, see paragraph [0015] of machine translation) that irradiates light onto the subject (32) of observation, wherein the auxiliary microscope is located such that the light irradiated onto the subject is visible (fig. 2)*." However, the Applicants respectfully disagree that the Kudo reference provides such a teaching. As dicsussed above, the portion of the Kudo reference cited by the Office Action only states that a light source for lighting is built into the 1st arm 6. However, the Kudo reference stating that a light source for lighting is built into 1st arm 6 says nothing about how the auxiliary microscope is located, and if it is located such that the irradiated light on the subject of observation is visible. As discussed above, the Kudo reference does not identically disclose, or even suggest, that the light source provides light to the subject of observation. Therefore, the Kudo reference also cannot possibly disclose, or even suggest, that the auxiliary microscope is located in such a away that the irradiated light on the subject of observation is visible. The office action further refers to Figure 2 of the Kudo reference, but Figure 2 of the Kudo reference does not indicate 1st arm 6, and thus can provide no teaching related to the light source. Thus, the Kudo reference does not identically disclose, or even suggest, the claimed "*auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible*."

The Shioda '371 reference fails to remedy the deficiencies of the Kudo reference. The Shioda '371 reference fails to identically disclose, or even suggest, the above-identified features, including at least the claimed "*laser light irradiation device that irradiates laser light that is coaxial with the optical axis of the probe microscope onto the subject of observation*," and that the "*auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible*." Instead, the Shioda '371 does not show illumination light that is irradiated coaxial with the optical axis of the probe microscope. For example, as depicted in the embodiments of Figures 1 and 7, the illumination light is not irradiated coaxial with the optical axis of the probe microscope. Thus, the Shioda '371 reference also necessarily cannot identically disclose, or even suggest, locating the auxiliary microscope such a that the laser light irradiated onto the subject is visible, because inherent to the irradiated light being on the subject is that the light was irradiated along the optical axis of the probe microscope. That is, the "irradiated" of the "*auxiliary microscope is located*

such that the laser light irradiated onto the subject of observation is visible," is a certain type of irradiated, i.e., an irradiated that resulted from irradiation along the optical axis of the probe. Thus, the Shioda '371 reference, as with the Kudo reference, does not identically disclose, or even suggest, irradiating a laser light along the optical axis of a probe microscope, and therefore necessarily cannot disclose, or even suggest, arranging an auxiliary microscope to view the light that has been irradiated along the optical axis of the probe microscope.

The Shioda '062 reference fails to remedy the deficiencies of the Kudo and Shioda '371 references. The Shioda '062 reference fails to identically disclose, or even suggest, at least the claimed "*auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible*." The Office Action relies on Figures 53 and 54 of the Shioda '062 reference to teach certain claimed features. However, the embodiment of the Shioda '062 reference shown in Figures 53 and 54 does not disclose, or even suggest, the locating of the auxiliary microscope so that the laser light irradiated onto the subject of observation is visible.

Firstly, the Applicants respectfully note that the claimed feature of the "*auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible*" must be given meaning in light of the specification. The embodiment corresponding to the claims currently under consideration is the tenth embodiment, as it is referred to in the specification (see, for example, the "Election of Species" submitted by the Applicant to the Office on January 25, 2006). Moreover, the specification describes the tenth embodiment as follows: "*[n]ote that, as a device for simplifying the positioning operation during macro observation, it is possible to employ a structure in which a laser light illumination device (for example, see the eleventh embodiment described hereinafter) is provided that irradiates laser light that is coaxial with the optical axis of the probe 12 onto the observation position of the subject of observation O1, and to confirm this irradiation position using the visual field of the video microscope 510*" (page 68, lines 6-11). Thus, the claimed feature of the "*auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible*" necessarily means visible to the auxiliary microscope.

Moreover, the Shioda '062 reference, for example in the embodiments shown in Figures 53 and 54, does not show that the laser light irradiated onto the subject of observation is visible to the auxiliary microscope. Instead, the laser light irradiated onto the subject of

observation in Figure 54, for example, is visible only to the endoscope 434 (i.e. probe microscope) and not to the operation microscope 401 (i.e. auxiliary microscope). Furthermore, the images shown in Figures 55-58, showing the irradiated laser light, are taken using the TV camera 447 located on the endoscope (i.e. probe microscope). Moreover, the images of Figures 59 and 60 are achieved using a video mixer, and so even in these images, the irradiated laser light is not visible to the operation microscope (i.e. auxiliary microscope). Thus, the Shioda '062 reference does not identically disclose, or even suggest, the claimed "*auxiliary microscope is located such that the laser light irradiated onto the subject of observation is visible*."

Therefore, for at least the foregoing reasons, independent claim 11, as well as its dependent claims 12 and 16-18, are patentable over the Kudo, Shioda '371 and Shioda '062 references.

CONCLUSION

Applicants respectfully submit that claims 11-12 and 16-18 of the present application under consideration are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

The Office is authorized to charge any required fees associated with this Amendment to Kenyon & Kenyon LLP's Deposit Account No. 11-0600.

Respectfully submitted,

Dated: December 11, 2006 By

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